

Serial No.: 10/723,058

RECEIVED
CENTRAL FAX CENTER

DEC 29 2006

REMARKS

Claims 1-7 are pending in the present application. Claims 1 and 6, and the specification are amended by this amendment. No new matter is introduced by the amendments, which find support throughout the specification and figures. In view of the amendments and the following remarks, Applicants respectfully request that the pending claims be allowed.

Claims 1-4 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claim 1 is amended to remove the term "operation", which merely referred to the method steps of the claim. It is respectfully submitted that the amendments to this claim, as well as claim 6, remove the use of word "operation", and therefore it is respectfully requested that the rejections be withdrawn.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent Publication No. 2003/0189912 to Laitinen et al. (hereinafter referred to as Laitinen) in view of United States Patent No. 5,701,585 to Kallin et al. (hereinafter referred to as Kallin).

Applicants respectfully traverse.

Claim 1 relates to a method of handover in a multimode mobile telecommunication network in which, to initiate a handover, the network sends to a mobile terminal a first group of system information via a first channel associated with circuit switching services and a second group of system information via a second channel associated with packet switching services. The method of claim 1 includes, *inter alia*, performing measurements at least in one neighboring cell on a basis of information contained in the second group of system information, and sending to the network the measurements performed in step a). The method according to amended claim 1 also includes performing measurements at least in one further neighboring cell on the basis of the information contained in the second group of system information, and further sending to the

Serial No.: 10/723,058

network the measurements performed in this step. In amended claim 1, *the further sending operation is performed in a message distinct from the sending operation.*

The Examiner asserts that Laitinen discloses a network that sends to the mobile terminal the first group of system information via the first channel after the performing measurements operation. The Examiner admits that Laitinen does not "disclose the features of c) further performing measurements at least in one further neighboring cell on the basis of the information contained in the second group of system information, and further sending to the network the measurements performed in step c), the further sending operation being performed in a message distinct from the sending operation" (Office Action; page 4, lines 15-18). The Examiner relies on Kallin as disclosing the feature of performing measurements in at least one additional neighboring cell, and sending to the network the measurements performed in the cell in a distinct message from the transmission of the measurements performed in the at least one neighboring cell.

The Examiner asserts that a practitioner in the art would be motivated to combine the references "because it is conventionally known that in a mobile assisted handoff (as used in Laitinen) a mobile terminal regularly measure and reports (i.e. distinct messages) the quality level of each of the cells assigned to the mobile terminal in order to find a good candidate for handoff" (Office Action; page 5, lines 6-9). However, this motivation appears to be the result of improper hindsight reasoning. The Federal Circuit has held that there must be "findings as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the] invention to make the combination in the manner claimed." (*In re Kotzab*, 217 F. 3d 1365, 1371 (Fed. Cir. 2000); emphasis added). The present

Serial No.: 10/723,058

rejection does not provide any suggestion, based on the references, indicating the *manner* in which the references should be combined.

The conclusory reasoning of the rejection is insufficient to support a claim of obviousness. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either *explicitly or implicitly in the references themselves or in the knowledge generally available* to one of ordinary skill in the art. (MPEP 2143.01, emphasis added). "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). It is respectfully submitted that there is no motivation provided in Kallin to suggest the combination with Laitenen. There must be *specific teaching* to motivate a person of ordinary skill in the art combine the prior art teachings *in the particular manner claimed*. The present rejection provides no motivation to combine the specific references, nor any citation to disclosure that would suggest the manner in which the references could be combined. Therefore, since there is no motivation to combine the references, and no suggestion of the manner in which the references should be combined, the rejection is improper, and amended claim 1 is allowable over the reference.

Claims 2-4 and 6 depend from claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable.

Claim 5 recites features similar to claim 1 and is therefore allowable for at least the same reasons as claim 1 is allowable.

DEC-29-2006 FRI 04:02 PM KATTEN MUCHIN ROSENMAN

FAX NO. 2129408986

P. 10/10

Serial No.: 10/723,058

Claim 7 depends from claim 5 and is therefore allowable for at least the same reasons as
claim 5 is allowable.

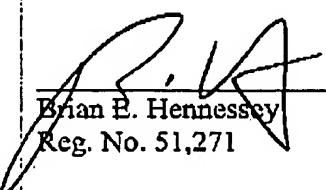
RECEIVED
CENTRAL FAX CENTERCONCLUSION

DEC 29 2006

In view of the remarks set forth above, this application is believed to be in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



Brian E. Hennessey
Reg. No. 51,271

CUSTOMER NUMBER 026304
KATTEN MUCHIN ROSENMAN
575 Madison Avenue
New York, NY 10022-2585
(212) 940-8800
Docket No.: NECW 20.768
BEH:pm

Serial No.: 10/723,058

RECEIVED
CENTRAL FAX CENTER

DEC 29 2006

REMARKS

Claims 1-7 are pending in the present application. Claims 1 and 6, and the specification are amended by this amendment. No new matter is introduced by the amendments, which find support throughout the specification and figures. In view of the amendments and the following remarks, Applicants respectfully request that the pending claims be allowed.

Claims 1-4 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claim 1 is amended to remove the term "operation", which merely referred to the method steps of the claim. It is respectfully submitted that the amendments to this claim, as well as claim 6, remove the use of word "operation", and therefore it is respectfully requested that the rejections be withdrawn.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent Publication No. 2003/0189912 to Laitinen et al. (hereinafter referred to as Laitinen) in view of United States Patent No. 5,701,585 to Kallin et al. (hereinafter referred to as Kallin). Applicants respectfully traverse.

Claim 1 relates to a method of handover in a multimode mobile telecommunication network in which, to initiate a handover, the network sends to a mobile terminal a first group of system information via a first channel associated with circuit switching services and a second group of system information via a second channel associated with packet switching services. The method of claim 1 includes, *inter alia*, performing measurements at least in one neighboring cell on a basis of information contained in the second group of system information, and sending to the network the measurements performed in step a). The method according to amended claim 1 also includes performing measurements at least in one further neighboring cell on the basis of the information contained in the second group of system information, and further sending to the

Serial No.: 10/723,058

network the measurements performed in this step. In amended claim 1, *the further sending operation is performed in a message distinct from the sending operation.*

The Examiner asserts that Laitinen discloses a network that sends to the mobile terminal the first group of system information via the first channel after the performing measurements operation. The Examiner admits that Laitinen does not "disclose the features of c) further performing measurements at least in one further neighboring cell on the basis of the information contained in the second group of system information, and further sending to the network the measurements performed in step c), the further sending operation being performed in a message distinct from the sending operation" (Office Action; page 4, lines 15-18). The Examiner relies on Kallin as disclosing the feature of performing measurements in at least one additional neighboring cell, and sending to the network the measurements performed in the cell in a distinct message from the transmission of the measurements performed in the at least one neighboring cell.

The Examiner asserts that a practitioner in the art would be motivated to combine the references "because it is conventionally known that in a mobile assisted handoff (as used in Laitinen) a mobile terminal regularly measure and reports (i.e. distinct messages) the quality level of each of the cells assigned to the mobile terminal in order to find a good candidate for handoff" (Office Action; page 5, lines 6-9). However, this motivation appears to be the result of improper hindsight reasoning. The Federal Circuit has held that there must be "findings as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the] invention to make the combination in the manner claimed." (*In re Kotzab*, 217 F. 3d 1365, 1371 (Fed. Cir. 2000); emphasis added). The present